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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/734,694 | 12/13/2000 | Rayi Ganesan | 335036 | 6528 |
| 20457 | 7590 | 07/26/2005 | EXAMINER | |
| ANTONELLI, TERRY, STOUT & KRAUS, LLP | | | COLBERT, ELLA | |
| 1300 NORTH SEVENTEENTH STREET | | | ART UNIT | |
| SUITE 1800 | | | PAPER NUMBER | |
| ARLINGTON, VA 22209-3873 | | | 3624 | |

DATE MAILED: 07/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,694

Applicant(s)

GANESAN, RAYI

Examiner

Ella Colbert

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04/25/05 & 06/06/05.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) 58 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-57 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04/25/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

1. Claims 1-57 are pending. Claim 58 has been canceled/withdrawn in Response to the Election Restriction Requirement filed 04/25/05 entered as Response To Election/Restriction and IDS. Claims 1-51 were elected for prosecution with traverse.
2. Claims 1-5, 8-53, 55-57, and 59 were elected, claims 6, 7, 54, and 58 were cancelled, and claims 2, 12, 13, 19, 33, 36, 46, 47, 50, and 52 have been amended in the Second Preliminary Amendment filed 07/06/05. The Restriction Requirement of the Office action of 04/03/05 still remains because Applicant's response to the Restriction Requirement is improper. **Applicant must elect one group to be examined though it may be with traverse (i.e. emphasis).** The restriction requirement still remains as set forth here below.
3. The IDS filed 04/25/05 has been entered and submitted with this Office action.

Election/Restrictions

4. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-51 drawn to processing bill payment information, classified in class 705, subclass 43.
 - II. Claims 52-57, drawn to receiving an instruction to pay a bill of the payee, classified in class 705, subclass 40.
5. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for

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patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed. The combination claims 1, 18, and 35 are directed to a method, system, and article of manufacture for "processing bill payment information identifying a payee to whom the payer intends to electronically direct payment and transmitting a notice to the payer that the bills of the payee are available electronically". The subcombination Group II, claims 52-57 has separate utility such as "receiving from a payer an instruction to pay a bill of a payee; accessing a database with information identifying at payees offering electronic bill presentment, determining if the payee is included in the database, and notifying the payer that the payee offers electronic bill presentment.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

7. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and the search for Group II is not required for Group I, restriction for examination purposes as indicated is proper.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Response to Arguments with Traverse

10. Applicant argues: Claims 1-59 are pending, claims 2, 5, 12-13, 16, 19, 32-33, 36, 42, 46, 47, 50, and 52 are further amended, and claims 6, 7, 54, and 58 are cancelled without prejudice or disclaimer in the Second Preliminary Amendment of June 6, 2005. Response: The Response to Restriction Requirement filed 04/25/05 states Applicants hereby elect Group I (claims 1-51 for prosecution in the above-identified application. Notwithstanding the above election, the restriction of Group I (claims 1-51) and Group II (claims 52-57) is hereby traversed and it is respectfully submitted that the Examiner's contention that the claims of Group I are distinct from the claims of Group II, fails to fully consider the limitations recited in the dependencies of for example claim 1. In any event, to avoid unnecessary prosecution on this issue, claims 52-53 and 55-57 are amended (in a Preliminary Amendment filed concurrently herewith) to depend from claim 1 and claim 54 has been cancelled has been considered. Response: The Election is considered improper because the Applicant is required to elect one single group of claims that were restricted **though the restriction be traversed**. A restriction is based on the independent claims. Where is Applicant's "receiving from the payer an instruction to pay a bill of a payee, accessing a database with information identifying at payees offering electronic bill presentment, and notifying the payer that the payee offers

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electronic bill presentment" in the independent claims of Group I of the originally filed claims which were present in the restriction requirement of 04/03/05?

Conclusion: The Examiner is confused as to what claims are to be examined since claims 1-51 were elected prior to the Second Preliminary Amendment filed 06/06/05. Applicant is respectfully requested to elect either Group I or Group II in this Restriction Requirement for prosecution on the merits in an effort to move the prosecution forward.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Monday-Thursday, 6:30AM-5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on 571-272-6747. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read "E. Colbert", with a long horizontal stroke extending to the right.

E. Colbert

July 14, 2005